

Docket No. 10807-008

C.O.M.
CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, DC 20231 on October 28, 1997.

Jolly Skafawski

PATENT

*#34
MATT
11-12-97*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Jonathan Nimitz et al : Group Art Unit: 2203

Serial No.: 08/269,323 : Examiner: J. Anthony

Filing Date: June 30, 1994 :

For: Fluoroiodocarbon Blends as CFC and Halon Replacements

REPLY BRIEF

NOV 4

*OK TO
Enter
8/8
NOTED
J.D.A.
11/14/97*
Assistant Commissioner of Patents
Washington, DC 20231

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated August 28, 1997.

I. NEW POINTS OF ARGUMENT

The following new points of argument are raised for the first time in the Examiner's Answer:

A. The sentence bridging pages 4 and 5 of the Examiner's Answer states that it is not necessary for a finding of *prima facie* obviousness that the applied reference shares the same reasons as applicants for using the said fluoroiodocarbon fire extinguishing agents as long as the reference either teaches or suggests that the selection of components will result in the disclosed effect, and cites *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990) in support thereof. This is a new point of argument raised for the first time in the Examiner's Answer.

B. At page six, the Examiner's Answer states that it has often been held that it would have been *prima facie* obvious for the artisan of ordinary skill in the art to select components from among many disclosed by the prior art as long as it is taught or suggested that the selection will result in the disclosed effect even when the possible selection numbers 1200 or greater, and cites *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804 (Fed. Cir. 1989) in support thereof. This is a new point of argument raised for the first time in the Examiner's Answer.

II. RESPONSE TO NEW POINTS OF ARGUMENT

Appellants respond to the new points of argument raised in the Examiner's Answer as follows:

A. With respect to the Examiner's reliance on *In re Dillon*, Appellants concede that a finding of *prima facie* obviousness does not require that an applied reference share the same reasoning or motivation that an applicant has for modifying the teachings of the prior art. However, in the present application, the single reference relied upon by the Examiner, *The Technical Report*, provides no motivation or suggestion as to the desirability of any blend containing a fluorooiodocarbon compound as required by the present claims. Moreover, with respect to the binary mixtures of halogenated compounds which are taught by *The Technical Report*, the reference itself further teaches that only some of the mixtures were advantageous so that no generalization as to binary mixtures could be made. Thus, unlike the prior art in *Dillon*, which specifically taught a desirable use for compounds equivalent to those of the subject claims, *The Technical Report* provides no teaching as to the desirability or advantage of using fluorooiodocarbon compounds in blends as presently claimed and does not teach the equivalence of the presently fluorooiodocarbon compounds with the components of the binary mixtures specifically set forth therein. Rather, *The Technical Report* teaches that the various halogenated

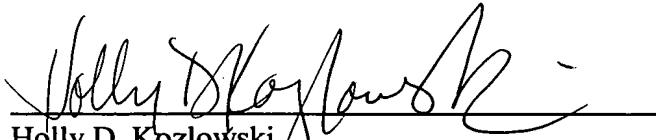
compounds are not equivalent for binary mixture purposes. Thus, *In re Dillon* is not pertinent to the present appeal.

B. Reliance on *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, is also not pertinent to the present application. That is, in the *Merck* case, the claimed formulations were a species of the prior art genus. However, in the present application, the blends of fluoroiodocarbon compounds and additive employed in the claimed methods of using a fire extinguishing agent are not generically disclosed in the cited prior art of *The Technical Report*. Rather, *The Technical Report* discloses binary mixtures of other compounds and, unlike the prior art in the *Merck* case, specifically states that generalizations cannot be made, and specifically that generalizations cannot be made with respect to binary mixtures. Thus, the *Merck* case does not support the obviousness rejection of the presently claimed methods.

III. CONCLUSION

For the reasons set forth above, the new points of argument raised by the Examiner's Answer are not persuasive and do not support a rejection of the present claims under 35 U.S.C. §103. Accordingly, for these reasons and those set forth in detail in Appellants' Appeal Brief, the methods of claims 157, 158, 160-167, 169-175 and 177-179 are nonobvious over and patentably distinguishable from *The Technical Report* and the rejection under 35 U.S.C. §103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,


Holly D. Kozlowski
Registration No. 30468
Dinsmore & Shohl
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202
(513) 977-8568

205043.01

208

Docket No. 10807-008

COPY M
CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, DC 20231 on October 28, 1997.

Holly D Kozlowski

PATENT

#23
NMT
11-12-97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Jonathan Nimitz et al : Group Art Unit: 2203

Serial No.: 08/269,323 : Examiner: J. Anthony

Filing Date: June 30, 1994 :

For: Fluoroiodocarbon Blends as CFC and Halon Replacements

BOARD OF PATENT AND TRADEMARK APPEALS

11-12-97 T 2 35

NOV 12 1997

REQUEST FOR ORAL HEARING

Attn: Board of Appeals
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Dear Sir:

In accordance with the provisions of 37 C.F.R. 1.194, Applicants request an oral hearing before the Board of Patent Appeals and Interferences. Please charge the \$135 government fee (small entity) to Deposit Account No. 04-1133. Please charge any additional

11/14/1997 fees required in connection with the present communication to Deposit Account No. 04-1133.
01 FC:221 FEE PEOPLE:00000016 DAH:041133 08269323
135.00 CH

Respectfully submitted,

Holly D Kozlowski

Holly D. Kozlowski
Reg. No. 30,468
DINSMORE & SHOHL LLP
1900 Chemed Center
255 E. Fifth Street
Cincinnati, Ohio 45202
(513) 977-8568